



Doc Code: AP.PRE.REQ

PTO/SB/SS (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

2052

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on January 16, 2007

Signature

Typed or printed

name Gautham Bodepudi

Application Number

10/659,647

Filed

September 10, 2003

First Named Inventor

Mark Yarkosky

Art Unit

2617

Examiner

Olumide Ajibade Akonai

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.Registration number 59,788☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

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312-913-3340

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January 16, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Case No. 2052

In re Application of:)
)
Mark Yarkosky) Group Art Unit: 2617
)
Serial No.: 10/659,647) Examiner: Ajibade Akonai, Olumide
)
Filed: September 10, 2003)
) Confirmation No. 3662
For: Method For Dynamically)
Directing a Wireless Repeater)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REASONS FOR REVIEW OF FINAL REJECTION

Applicant respectfully requests review of the final rejection mailed August 25, 2006, because the Examiner has improperly rejected the claims under 35 U.S.C. § 103(a). In particular, the Examiner has not established a suggestion or motivation to combine the references. According to M.P.E.P. § 2143, without a suggestion or motivation to combine the references, a *prima facie* case of obviousness of the claims over the references does not exist. Hence, the Examiner's 35 U.S.C. § 103(a) rejection of the claims is improper.

1. The Claimed Invention

Claims 1, 7, 9-12, 14-24, and 26-31 are pending in this application. Of these, claims 1, 7, 16, and 23 are in independent format, and the rest are in dependent format.

Each of claims 1, 7, 9-12, 14-24, and 26-31 includes, at least, the functions of dynamically directing a wireless repeater to receive wireless signals from a plurality of base

stations. Specifically, claims 1, 7, 9-12, 14, 15, 23, 24, and 26-31 includes the function of causing an antenna of a wireless repeater to sweep over a coverage area through increments, and to thereby receive wireless signals from a plurality of base stations. Each of claims 16-22 includes a similar function of “incrementally adjusting the wireless repeater to receive wireless signals within the number of coverage areas, and to thereby receive wireless signals from a plurality of base stations.”

2. The Examiner Erred in Rejecting Independent Claims 1, 7, 16, and 23

The Examiner has improperly rejected independent claims 1, 7, 16, and 23 under 35 U.S.C. § 103(a). In particular, the Examiner has incorrectly asserted that the independent claims are obvious over a combination of U.S. Patent No. 7,003,261 (Dietz) and U.S. Patent No. 6,782,277 (Chen). Applicant respectfully refers the panel to the arguments set forth in Section 3(c) of Applicant's Response After Final (filed October 25, 2006), which explain in detail how the Examiner has erred in making this rejection.

As a brief overview, in the Response After Final, Applicant traversed the obviousness rejection of the independent claims 1, 7, 16, and 23 by arguing that the Examiner failed to properly establish a suggestion or motivation to combine Dietz and Chen, because combining Dietz and Chen in the manner suggested by the Examiner would render Dietz unsatisfactory for its intended purpose (“inoperability argument”). See M.P.E.P. § 2143.01 (V), quoting *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984) (“If [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.”). Specifically, Applicant noted that adding the functionality of Chen (i.e., adding the *teaching* of how Chen enables a beam-sweeping antenna function) to Dietz, as the Examiner suggested, would actually *decrease* the likelihood that a

communication path will be established between a base station and a mobile station via a sequential set of routers installed into cars. Hence, the proposed combination would render Dietz unsatisfactory for its intended purpose of *increasing* the likelihood that such a connection will be established.

In the Advisory Action mailed November 28, 2006, rather than responding to Applicant's inoperability argument, the Examiner recited from the M.P.E.P. that "the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art." Advisory Action, pg. 2.

However, Applicant did not assert that the test for obviousness is whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference. Moreover, Applicant did not argue whether Chen *could* be bodily incorporated into the structure of Dietz. Rather, Applicant argued that: (i) *combining* Dietz and Chen in the manner suggested by the Examiner would render Dietz unsatisfactory for its intended purpose, (ii) as such, the Examiner failed to establish a suggestion or motivation for combining the references, and (iii) therefore, a *prima facie* case of obviousness over the references does not exist.

Notwithstanding the Examiner's argument that a motivation for combining Dietz and Chen may be found in the summary of Chen, the Examiner failed to rebut the argument that combining Dietz and Chen in the manner suggested by the Examiner would render Dietz unsatisfactory for its intended purpose. According to the M.P.E.P., in a case where the proposed combination would render the primary reference unsatisfactory for its intended purpose, no suggestion or motivation exists for combining the references. *See* M.P.E.P. § 2143.01 (V).

Applicant agrees with the Examiner's observation that "the test [for obviousness] is what the combined teachings of those references would have suggested to those of ordinary skill in the art." M.P.E.P. § 2145 (III), quoting *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). In fact, in the Response After Final, Applicant specifically argued that adding the *teaching* of Chen to Dietz would render Dietz unsatisfactory for its intended purpose. In particular, Chen *teaches* that communications between a base station equipped with a beam-sweeping antenna and a mobile station are generally *delayed* until the signal beam of the base station is *pointed toward* the mobile station. See, e.g., Chen, col. 6, lines 35-39 (The "[b]ase station 102 buffers user data addressed to a subscriber station until signal beam 110 reaches the signal beam angle that is optimal for transmitting to that subscriber station."); col. 18, lines 12-15 ("These periods generally correspond to the periods when beam sweeping base station 102 is receiving along a signal beam *pointed toward* subscriber station 108" (emphasis added)).

If, as the Examiner suggested in the Final Office Action mailed August 25, 2006, the "functionality" of "an antenna sweeping over a coverage area through increments and receiving wireless signals at increments" is added to Dietz from Chen (See Final Office Action, pg. 20), then the *teaching* of delaying transmission until the signal beam of the antenna is pointed toward its target would also be added to Dietz. However, adding the *teaching* of delayed transmission to Dietz would actually *decrease* the likelihood that a communication path will be established between a base station and a mobile station via a sequential set of routers installed into cars. As such, combining Dietz and Chen in the manner suggested by the Examiner would render Dietz unsatisfactory for its intended purpose. Hence, the Examiner has failed to establish a suggestion or motivation for combining Dietz and Chen. Therefore, a *prima facie* case of obviousness of

these claims over Dietz and Chen does not exist. Applicant thus respectfully submits that independent claims 1, 7, 16, and 23 are allowable over the cited references.

3. The Examiner Erred in Rejecting Dependent Claims 9-12, 14, 15, 17-22, 24, and 26-31

Without addressing the Examiner's statements regarding the pending dependent claims 9-12, 14, 15, 17-22, 24, and 26-31, which are not conceded, Applicant points out that each of these claims depend from and incorporate the limitations of at least one of independent claims 1, 7, 16, and 23, which, as discussed above, are allowable over the cited art. Accordingly, claims 9-12, 14, 15, 17-22, 24, and 26-31 are allowable for at least the reason that they each depend from an allowable claim.

4. Conclusion


For these reasons, Applicant respectfully requests the panel to withdraw the rejections of all of the pending claims, and to direct that a Notice of Allowance be mailed.

Respectfully submitted,

**MCDONNELL BOEHNEN
HULBERT & BERGHOFF LLP**

Date: January 16, 2007

By: _____


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